

ADMINISTRATIVE PANEL DECISION

San Mauro S.P.A. v. My Store Admin, Outlet 5Terre
Case No. D2025-0080

1. The Parties

The Complainant is San Mauro S.P.A., Italy, represented by Bugnion S.p.A., Italy.

The Respondent is My Store Admin, Outlet 5Terre, Italy.

2. The Domain Name and Registrar

The disputed domain name <outlet5terre.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 9, 2025. On January 10, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent (Contact Privacy Inc. Customer 0173313302) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 13, 2025, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on January 17, 2025.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 20, 2025. In accordance with the Rules, paragraph 5, the due date for Response was February 9, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 10, 2025,

The Center appointed Federica Togo as the sole panelist in this matter on February 17, 2025. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

It results from the Complainant's undisputed allegations that it is a company that owns and manages the "Brugnato 5terre Outlet Village", an apparel outlet located in Brugnato in the Italian region of Liguria. The outlet, counting more than 70 shops, was opened on April 12, 2014. In 2024, it celebrated its 10th anniversary, recording 20 million visitors over the decade.

The Complainant currently runs an official website, including a web shop, under the following domain name <brugnato5terreoutletvillage.it>, registered on May 16, 2018, and currently registered in the name of "Consorzio Shopinn". This website and its subpages are consistently and prominently marked at the top of the pages with the Complainant's BRUGNATO 5TERRE OUTLET VILLAGE trademark and device logo.

It results from the Complainant's allegations and undisputed evidence, i.e. Italian media, including newspapers, that:

- the Complainant uses consistently the sign BRUGNATO 5TERRE OUTLET VILLAGE to designate its shopping outlet since 2014;
- the Brugnato 5terre Outlet Village achieved 20 million visitors over the decade, of which 35% were tourist, half of whom were foreigners;
- the Brugnato 5terre Outlet Village's revenues doubled between 2014 and 2024, with an average growth of 13% in the first five years. Since 2020, growth was averaged 10% per year;
- The Brugnato 5terre Outlet Village has over hundred employees circa, with an income distributed of EUR 6,800,000;
- The Brugnato 5terre Outlet Village has been organizing several summer events with Italian artists.

The Complainant filed an Italian trademark application for BRUGNATO 5TERRE OUTLET VILLAGE and device logo on December 2, 2024 for services in class 35, which is currently pending.

The disputed domain name was registered on November 23, 2024. Furthermore, the undisputed evidence provided by the Complainant proves that the disputed domain name resolved to a web shop prominently displaying the Complainant's BRUGNATO 5TERRE OUTLET VILLAGE and device logo without the Complainant's approval/authorization and offering the possibility to buy apparel at heavily discounted prices.

The undisputed evidence provided by the Complainant shows that customers who bought from the website "outlet5terre.com" thought that they were buying from "Brugnato 5terre Outlet Village" and complained to the Complainant that these products were allegedly counterfeit.

The disputed domain name is currently not reachable, and the following wording appears "This store is unavailable". On this regard, the Complainant provided evidence of a "Trademark Infringement Notice" submitted to "shopify" on December 3, 2024 by "Consorzio Shopinn", i.e. the owner of the domain name <brugnato5terreoutletvillage.it>.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's earlier unregistered trademarks (under Italian national law) and to the Complainant's own domain name.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, it has not provided authorization to register or deploy the trademark in a domain name nor in any other manner to the Respondent. Also, no authorization was granted regarding the content of the website associated with the disputed domain name. Moreover, the Respondent has full knowledge of the Complainant's rights and trademarks as it is undisputedly and slavishly copied the actual stylized trademark used and protected by the Complainant including the fanciful graphic element. Thus, the Respondent's intent is to take advantage of the popularity of the Complainant's trademark well-known over the several years and mislead consumers.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, based on the fame built over the years by the Complainant, the Respondent has decided to register the disputed domain name with the intent to take advantage of the Complainant's positive reputation. In addition, the Respondent's web page had been designed as a mirror site of the Complainant's. In fact, the webpage's content has published the Complainant's earlier rights also including the same allegedly counterfeit products sold under the trademarks KWAY, NAPAPIJRI, NORTH FACE, MONCLER. Not to mention that the products themselves show unrealistic prices suggesting that counterfeiting may occur. Moreover, thanks to the purchase made by some costumers the Complainant was able to find some details of the items supporting the suspicion. The wrongdoing is, also, confirmed by the numerous emails the Complainant has received from customers complaining and requesting responses as to the origin of the products bought from the website "outlet5terre.com" thinking that the source of business be "Brugnato 5terre Outlet Village".

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable". Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 1.7.

The Complainant filed an Italian trademark application for BRUGNATO 5TERRE OUTLET VILLAGE and device logo on December 2, 2024 for services in class 35, which is currently pending. In this regard, the Panel notes that a pending trademark application does not by itself establish trademark rights within the meaning of UDRP paragraph 4(a)(i) [WIPO Overview 3.0](#), section 1.1.4.

However, the Panel finds the Complainant has established unregistered trademark or service mark rights for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.3.

In particular, the Panel is of the view that the Complainant has shown that its sign BRUGNATO 5TERRE OUTLET VILLAGE has become a distinctive identifier which consumers associate with the Complainant's goods and/or services at least in the Ligurian area. It results from the Complainant's allegations and undisputed evidence, i.e. Italian media, including newspapers that:

- the Complainant uses consistently the sign BRUGNATO 5TERRE OUTLET VILLAGE to designate its shopping outlet since 2014;
- the BRUGNATO 5TERRE OUTLET VILLAGE achieved 20 million visitors over the decade, of which 35% were tourist, half of whom were foreigners;
- the BRUGNATO 5TERRE OUTLET VILLAGE's revenues doubled between 2014 and 2024, with an average growth of 13% in the first five years. Since 2020, growth was averaged 10% per year;
- the BRUGNATO 5TERRE OUTLET VILLAGE has four hundred employees circa, with an income distributed of circa EUR 6,800,000.
- the BRUGNATO 5TERRE OUTLET VILLAGE has been organizing several summer events with Italian artists.

In the present case, the Respondent is shown to have been targeting the Complainant's mark BRUGNATO 5TERRE OUTLET VILLAGE, based on the manner in which the related website was used. In the Panel's view, this fact supports the Complainant's assertion that the sign BRUGNATO 5TERRE OUTLET VILLAGE has achieved significance as a source identifier. [WIPO Overview 3.0](#), section 1.3.

In fact, the undisputed evidence provided by the Complainant proves that the disputed domain name resolved to a web shop prominently displaying the Complainant's BRUGNATO 5TERRE OUTLET VILLAGE and device logo without the Complainant's authorization and offering the possibility to buy apparel at heavily discounted prices. The undisputed evidence provided by the Complainant further shows that customers who bought from the website "outlet5terre.com" thought that they were buying from "Brugnato 5terre Outlet Village" and complained to the Complainant that these products were allegedly counterfeit.

In the present case, the conclusion that the sign BRUGNATO 5TERRE OUTLET VILLAGE has achieved significance as a source identifier is convincing and no other plausible conclusion is apparent. Finally, this significance as a source identifier may only exist in the particular geographical area of Liguria. However, it is well acknowledged amongst previous panels that for a number of reasons, including the global nature of the Internet and Domain Name System, this does not preclude the complainant from establishing trademark rights (and as a result, standing) under the UDRP. [WIPO Overview 3.0](#), section 1.3.

The Panel finds that sufficient aspects of the relevant mark (i.e. "5terre" and "outlet") are recognizable within the disputed domain name even though the order of these elements is reversed within the disputed domain name. Moreover, the content of the website associated with the disputed domain name confirms the confusing similarity under the first element. [WIPO Overview 3.0](#), section 1.15. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel notes that the disputed domain name is clearly constituted by some features of the Complainant’s unregistered trademark (i.e. “5terre” and “outlet”). The content of the website to which the disputed domain name resolved suggest sponsorship or endorsement by the Complainant, which prominently displays the Complainant’s BRUGNATO 5TERRE OUTLET VILLAGE and device logo without the Complainant’s approval/authorization and offering the possibility to buy apparel at heavily discounted prices. In addition, the undisputed evidence provided by the Complainant shows that customers who bought from the website “outlet5terre.com” thought that they were buying from “BRUGNATO 5TERRE OUTLET VILLAGE” and complained to the Complainant that these products were allegedly counterfeit.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

One of these circumstances is that the Respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

In the present case, the Panel notes that it results from the Complainant’s documented allegations that the disputed domain name resolved to a web shop prominently displaying the Complainant’s BRUGNATO 5TERRE OUTLET VILLAGE and device logo without the Complainant’s authorization and offering the possibility to buy apparel at heavily discounted prices. The undisputed evidence provided by the Complainant shows that customers who bought from the website “outlet5terre.com” thought that they were buying from “Brugnato 5terre Outlet Village” and complained to the Complainant that these products were allegedly counterfeit. For the Panel, it is therefore evident that the Respondent positively knew the Complainant and its business under the source identifier BRUGNATO 5TERRE OUTLET VILLAGE.

In fact the evidence in the case file as presented does indicate that the Respondent’s aim in registering the disputed domain name was to profit from or exploit the Complainant’s trademark and that the Respondent did register the disputed domain name in bad faith targeting of the Complainant or its trademark rights.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In this regard, the further circumstances surrounding the disputed domain name's registration and use confirm the Panel's findings that the Respondent has registered and is using the disputed domain name in bad faith:

(i) the content of the website to which the disputed domain name directs, displaying the Complainant's BRUGNATO 5TERRE OUTLET VILLAGE and device logo without the Complainant's approval/authorization and offering the possibility to buy apparel at heavily discounted prices;

(ii) absence of rights or legitimate interests coupled with no response for the Respondent's choice of the disputed domain name;

(iii) the complaints from customers who bought from the website "outlet5terre.com";

(iv) the Respondent concealing its identity behind a privacy service; and

(v) the failure to submit a response by the Respondent.

The Panel finds that the Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <outlet5terre.com> be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: March 3, 2025